

REMARKS

Claims 12, 19, 20 and 22 have been amended and no claims have been cancelled. Accordingly, Claims 2, 4, 6 - 10, 12, 14 and 19 - 39 are pending in the subject application and presented for consideration.

Applicants have amended the Specification to further clarify that transverse curl is the curl "along" (not "around") the transverse axis of the binder strip. This is clear from Fig. 3 of the subject application which is said to show "transverse curl" in the Brief Description of the Drawings and other portions of the Specification, including original Claim 1.

In the subject Office Action, all pending claims were again rejected for being unpatentable over various prior art references. Claims 6, 7 and 8 were rejected for being anticipated by USPN. 4,471,976 to Giulie (hereinafter Giulie). Claims 6, 7, 12 and 39 were rejected for being anticipated by USPN. 4,800,110 to DuCorday (hereinafter DuCorday). Claims 6, 7, 20 - 23, 26, 28, 29, 33, 34, 35, 38 and 39 were rejected for being anticipated by USPN. 4,371,195 to Wang (hereinafter Wang). Claims 2, 4, 6-10, 12, 14 and 19 - 39 were rejected for being obvious over prior art mentioned in the subject application (ADPA) in view of either USPN. 4,247,273 to Pogrzebra (hereinafter Pogrzebra) or USPN. 4,612,230 to Liland (hereinafter Liland). All of these rejections are respectfully traversed.

Applicants will first address the comments made by the Examiner regarding a "Declaration under 37 CFR 1.132 filed December 4, 2007." It is not clear which declaration is being referred to by the Examiner. Applicants submitted a "Declaration of Eugene Anderson Pursuant to Rule 132" with exhibits (hereinafter "Anderson Declaration") together with a "Response to Rejection Mailed on May 31, 2006", both of which were mailed November 29, 2006. Later, Applicants submitted a "Supplemental Declaration of Eugene Anderson Pursuant to Rule 132" (hereinafter "Supplemental Anderson Declaration") together with a Response to Rejection Mailed on March 22, 2007," both of which were

mailed on July 22, 2007. In any event, it is believed that the Examiner's comments would apply to both Rule 132 Declarations.

The Examiner stated that the declaration in question was insufficient because "the Declaration does not state that the work was done in the US/NAFTA/WTO country". [page 6 of October 17, 2007 Office Action] Applicants are not aware of any such requirement for Rule 132 declarations used to submit evidence of patentability. Applicants suspect that the Examiner is referring to Rule 131 declarations used to "swear behind" a cited reference. In that case, such a statement regarding US/NAFTA/WTO is required [MPEP §715.07(c)]. No such statement is required for a Rule 132 declaration [MPEP §716]. If the Examiner disagrees, Applicants request a citation to some authority.

Applicants would like to first address those independent claims that were rejected solely under §103 for being obvious over the ADPA in view of either Liland or Pogrzebra (Claims 2, 14 and 19). Note that Claim 19 has been amended to recite that the grooves in the adhesive "operate to substantially reduce binder strip curl along the transverse axis" of the binder strip substrate. The ADPA discloses a conventional binder strip. As described in detail in the previous response, Liland discloses a method of increasing the "drape" (ability to conform to skin contours) of a surgical tape by forming indentations by forming indentations in the substrate 11 and not the adhesive 14. Applicants' invention relates to decreasing curl by manipulating an adhesive whereas Liland discloses increasing drape manipulating the substrate only.

Continuing, Pogrzebra shows that the edges of a thermo plastic web can be 5 can be treated by stamping both the top and bottom surfaces of the web edges so that the web edges are "cambered" that is, so that the edges of the web are thickened and roughened. This procedure of thickening the web edges is said to take the pressure off the center regions of the web (which are not treated) when the web is rolled up on a roll (Col. 1, lines 16 – 25). It is not seen how this reference, which teaches that the outer edges of a substrate, having no adhesive, can be thickened by punching holes in the edges of the substrate has any bearing whatsoever on the rejected claims.

Neither Liland nor Pogrzebra provide any suggestion that curl of the ADPA binder strip could be reduced by way of conditioning the strip adhesive as recited in the rejected claims. The fact that binder strip curl is reduced in this manner, as clearly established by both the Anderson Declaration and the Supplemental Anderson Declaration, is surprising and unexpected. This objective evidence of non-obviousness, which must be considered by the Examiner in accordance with MPEP §716.01(d) and in accordance with the new Examination Guidelines for Determining Obviousness at MPEP §2141, establishes the patentability of the rejected claims.

Claims 4, 27, 30, 31, 32, 36 and 37 all depend, either directly or indirectly, from one of the rejected independent Claims 2, 14 and 19 and add patentably significant limitations to those claims. Thus, for at least the reasons set forth above regarding the independent claims, it is submitted that these dependent claim are also patentable.

As previously noted, independent Claims 6 was rejected for being anticipated by Giulie. This rejection makes no reference to physical properties of the claimed binder strip that are described in detail if the Anderson Declarations that function to "substantially reduce curling of the binder member along the transverse axis" as recited in the claim. As set forth in detail in the previous Response filed on July 26, 2007, Giulie does not possess these physical properties. Thus, Claim 6 is not anticipated by this reference.

Independent Claim 6 was also rejected for being anticipated by either DuCorday or Wang. Again, these rejections make no reference to the physical properties of the claimed subject matter, physical properties not possessed by either DuCorday or Wang as set forth in detail in July 26, 2007 Response. Thus, Claim 6 is also not anticipated by either of these references.

With respect to the rejections of Claim 6 under §103 for being obvious over the ADPA in view of either Liland or Pogrzebra, it is submitted that the subject matter of Claim 6 is patentable over these references for at least substantially the same reasons that Claim 2 is patentable, as described above in detail. Claims 7, 8, 9, 10, 28, 29 and 35 all depend, either directly or indirectly, for allowable Claim 6 and add patentably significant limitations to the claim. For at least that reason, it is submitted that these dependent claims are also patentable.

Independent Claim 12 was also rejected for being anticipated by either DuCorday or Wang. The claim was further rejected under §103 for being obvious over the ADPA in view of either Liland or Pogrzebra. Claim 12 has been amended to recited that the "deforming" of the adhesive, which takes place after cooling, results "in a substantial reduction in binding member curl along the transverse axis" of the binding member substrate. For at least substantially the same reasons noted above regarding independent Claim 6, it is submitted that Claim 12 is allowable over the cited prior art. It is also submitted that Claim 39, which depends from allowable Claim 12 and adds patentably significant limitations to the claim, is also allowable.

Independent Claim 20 was rejected for being anticipated by Wang and for being obvious over the ADPA in view of either Liland or Pogrzebra. Claim 20 has been amended to correct an error in the claim so that "the grooves [are] formed in the adhesive when the adhesive was no longer in the molten form" as when the adhesive was previously applied to the substrate. Again, for at least substantially the same reasons set forth above regarding Claim 6, it is submitted that Claim 20 is patentable over the cited prior art. It is further submitted that Claims 21 and 38, which depend from allowable Claim 20 and add patentably significant limitations to the claim, are also allowable.

Independent Claim 22 was also rejected for being anticipated by Wang and for being obvious over the ADPA in view of either Liland or Pogrzebra. Claim 22 has been amended to delete any reference to the circumstances under which the "mechanical deformations" are added to the adhesive. Claim 22 further recites that the both surfaces of the substrate "are both substantially smooth in all of the substrate regions directly opposite the mechanical deformations in the adhesive". Wang discloses adding adhesive deformations to facilitate folding, not curl reduction. As a consequence, Wang has provided scores 20 in the substrate (See Figs 1 – 5) for this purpose. Claim 22 is directed to a binder member where deformations are present for purposes other than facilitating folding, with Claim 22 excluding the presence of scores 20 and the like. Thus, there is clearly no anticipation by Wang. Further, if Wang were to be modified for some unknown reason to delete scores 20, the functionality of Wang would be severely diminished. Thus, it is believed that Claim 22 is also patentable over Wang under §103. With respect to the

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rejection of Claim 22 for being obvious under §103 over the ADPA in view of either Liland or Pogrzebra, as previously described, none of these references disclose introducing deformations into any adhesive for any purpose. Thus, it is believed that Claim 22 is further patentable over these references.

Claims 23 – 26, 33 – 34 all depend, either directly or indirectly, from independent Claim 22 and add patentably significant limitations to the claim. Thus, for at least the same reasons set forth above regarding Claim 22, it is submitted that these claims are also patentable.

In conclusion, all pending claims are believed to be in condition for allowance and an early allowance is respectfully requested.

Respectfully submitted,

GIRARD & EQUITZ LLP

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By: 

Philip A. Girard
Reg. No. 28,848

Attorneys for Applicant(s)

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